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EXAMINER

ONEILL, M

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

09/25/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

69/092,489

Applicant(s)

L. J. et al.

Examiner

O'NEILL

Group Art Unit

3713

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 7-14-03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-4, 6-9, 11, 13-14, 20-24, 26-33, 55-67 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4, 6-9, 11, 13-14, 20-24, 26-33, 55-67 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 14
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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**DETAILED ACTION*****Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 11, 20, 27, 55 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodenmann et al. in view of Junod et al., U.S. Patent No. 5,854,621 and, in the alternative, Collins et al, U.S. Patent No. 5,855,483, in view of Bodenmann et al. and Junod et al.

3. Bodenmann et al. discloses a method and apparatus for establishing a standardized communications protocol for wireless communications between a host, e.g. a game console and at least one peripheral device, e.g. gamepads. Each peripheral device includes a switch and a transmitter operating at a predefined frequency. The system includes a receiver unit, connected to the host, for receiving the data, decoding and processing as necessary. The peripheral device may also include a receiver along with a transmitter such that bi-directional communications are possible. Bodenmann et al. also discloses the well known "autofire" feature present in game controllers, and provides a particular implementation for such in the disclosed wireless system. See col. 9:35-42 and particularly "To minimize power consumption, the autofire function or other similar continuous-on functions are preferably maintained by the host receiver, since this minimizes power consumption

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at the remote device.” In order to provide further clarity with respect to there being a physical interface object between a peripheral device and the host, a co-pending patent to Junod et al. is being brought into the rejection in order to show, as seen in figure 1, a separate and distinct interface 20 between the host 30 and a controller 10. Also, in order to respond to Applicants’ remarks against the use of inherency, the Collins et al reference is being brought into the rejection to show that the genus of computers, which include the species of game consoles, have output displays, e.g. visual display units. In the alternative, Collins et al. as clearly shown in figure 1, discloses a wireless control unit 40, a console interface 20 and a game console 10 having a display 14 to which at least one spite (not shown) is controlled by the unit 40. Then, Bodenmann et al and Junod et al. are used to provide a teaching of how to enable such an invention without undue experimentation. Therefore, the claimed invention is found to be obvious from the disclosures, teachings and suggestions found in the references used herein.

4. Claims 2, 6, 8-10, 13, 15, 17, 18, 21-24, 28-32, 56-59, 61-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodenmann et al. in view of Junod et al. further in view of Takeda et al. and Nishiumi et al., U.S. Patent No. 5,897,437, and further in view of Cheng, U.S. Patent No. 6,019,680, Garrido and Nakanishi.

5. The disclosures and teachings of Bodenmann et al. and Junod et al. has been discussed above and incorporated herein.

6. The differences between the claims and the teachings of Bodenmann et al. and Junod et al. lie in the particular housing configuration as claimed, the provision of an ancillary peripheral device

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in the controller, as well as a memory cartridge for storing game related information in the receiver unit and the provision of a plurality of such controllers and receiver units for multi-player action. These differences will be addressed *seriatim*.

7. Takeda et al. shows and teaches a conventional game controller for the NINTENDO N64 video game system, known in the art as the "N64 Controller". This controller has the exact housing structure claimed, and includes peripheral units such as a memory unit attached to the back of the housing. This memory unit, also known in the art as an expansion cartridge, is for storing game related data, see col. 11:20-55. Official notice is taken that in addition to memory units, vibrating units such as the N64 RUMBLE PAK were well known in the art at the time of the invention, see Nishiumi et al., figure 14 and col. 9:47 through col. 10:56. These units, with or without memory, are inserted into the same expansion slot and provide vibration to the user's hands in response to the game action. Further, as taught in Takeda et al. at col. 11:60 through col. 12:12, the advantages of providing the memory unit on the controller over providing the slots on the game machine unit is explained to those skilled in the art.

8. Wireless game controllers are well known in the art, as admitted by the Applicants and disclosed in Bodenmann et al. In looking to provide a wireless controller for an N64 system, one of ordinary skill in the art would consider Takeda et al., and modify the game pads of Bodenmann et al to the housing of Takeda et al. Further, in providing such a wireless controller, one of ordinary skill in the art would consider the power requirements of the wireless controller, as such must be powered by batteries. The provision of the memory cartridge in the controller housing would

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consume power - leading one to look for a different arrangement. Given that Bodenmann et al. suggests the provision of the autofire feature in the receiver unit to reduce power consumption at the controller, and Takeda et al. teaches away from providing the memory unit at the game console, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the memory unit of Takeda et al. in the receiver units of Bodenmann et al., in order to provide the desirable features known to the N64 controller in a wireless format while maintaining reasonable power consumption in the wireless units. Doing such would leave the expansion slot available on the controller unit for other peripherals such as a vibration pack. Further, it would have been obvious to provide multiple receiver units as necessary, in order to provide for multi-player action and each player having a memory unit available to him.

9. Claims 3, 7, 14, 16, 26 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art listed above, as applied to the claims listed above, and further in view of Khoury.

10. The difference between these claims and the above listed prior art used in the above listed claims, lie in the provision of a "sleep" feature to the controller system. While Figure 2 of Bodenmann et al. does have a block labeled Sleep, Bodenmann et al. appears silent with respect to this element/feature.

11. As admitted by the Applicants, the provision of a sleep feature is game controllers both wired and wireless is known in the art. Khoury is cited in support of this position: for the discussion in the background as well as for the general teaching of conserving power in a controller by the addition of a sleep or power down feature in a game controller. Accordingly, it would have been obvious to

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one skilled in the art at the time of the invention to modify the wireless controller of Bodenmann et al., as modified above, to further incorporate a sleep feature in order to conserve power upon switch inactivity.

***Response to Amendment***

12. Applicants' arguments filed 7-14-00 have been fully considered but they are not persuasive.

13. The Applicants opine that Bodenmann et al. "clearly teaches that the wireless interface must be within the host," Amendment of 7-14-00 page 12. Respectfully, this is incorrect. Bodenmann et al. apparently does not clearly teach the physical location of the interface to the satisfaction of the Applicants. However, those skill in the art would agree that Bodenmann et al. clearly discloses that there is an interface. Although, it is well known to those skilled in the art that the interface most likely external to the host, the Examiner has brought in the references of Junod et al., which was a co-pending application incorporated by reference in Bodenmann et al. and Collins to bolster the position that the interface for wireless communication is external to the host. Cheng also teaches, abet with wired controllers, have a controller interface separate from the host, e.g. a game console.

14. The Applicants opine that one skilled in the art could not look to Bodenmann et al. for the teaching of providing "the auto-fire feature provided through a console interface connected to the game via the game controller ports," Amendment of 7-14-00 page 13.

15. Bodenmann et al. discloses the well known "autofire" feature present in game controllers known in the art, see col. 9:35-42. Also, those skilled in the art recognize that Bodenmann et al. contains an interface to facilitate communication between a controller and the host. Any auto-fire

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signals would have to go through the interface to get to either a controller or to the host, game console. Therefore, the auto-fire feature would be provided through the interface as claimed by the Applicants.

16. The Applicants opine that Bodenmann et al. "discloses receiver units within the host." The Examiner respectfully disagrees with such a proposition and suggests the Applicant review Bodenmann et al. particularly figure 1 which shows a receiver 25 and a host 20 and Junod et al. figure 1 which shows a receiver 20 with an arrow pointing to the host 30.

17. The Applicants opine that the rejection is improper because the Applicants' invention converts a wired controller into a wireless controller. Such a limitation of "converting a wired controller into a wireless controller" is not present in the claims which is what is being rejected not the invention disclosed by the Applicants. Therefore, it is irrelevant whether or not the prior art used in the rejection does such a conversion.

18. In sum, what is claimed by the Applicants is either disclosed, taught or suggested, alone or in combination, by the prior art used in the rejections.

### *Conclusion*

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



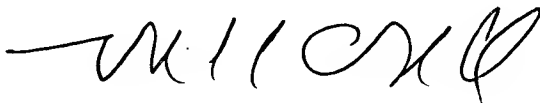
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Mike O'Neill whose telephone number is (703) 308-3484.

MON

September 21, 2000

A handwritten signature in black ink, appearing to read 'MICHAEL O'NEILL', with a stylized flourish at the end.

**MICHAEL O'NEILL**  
**PRIMARY EXAMINER**